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PTO/SB/21 (08-00)

**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

<b>Application Number</b>	10/072,931		
	<b>Filing Date</b>	February 12, 2002	
	<b>First Named Inventor</b>	Shunpei YAMAZAKI et al.	
	<b>Group Art Unit</b>	2812	
	<b>Examiner Name</b>	S. Isaac	
<b>Total Number of Pages in This Submission</b>		<b>Attorney Docket Number</b>	0756-2433

**ENCLOSURES (check all that apply)**

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input checked="" type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Declaration and Power of Attorney <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <b>Remarks</b> <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 50-2280 for the above identified docket number.	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosures 1. 2. 3. 4. 5. 6.
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**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual name	Eric J. Robinson, Reg. No. 38,285 Robinson Intellectual Property Law Office, P.C. PMB 955 21010 Southbank Street Potomac Falls, VA 20165
Signature	
Date	August 7, 2006

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

Type or printed name	Adele M. Stamper		
Signature		Date	August 7, 2006

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Attorney Docket No. 0756-2433

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Shunpei YAMAZAKI et al.

Serial No. 10/072,931

Filed: February 12, 2002

For: METHOD OF MANUFACTURING A  
SEMICONDUCTOR DEVICE

) Group Art Unit: 2812

) Examiner: Stanetta D. Isaac

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2006.

*Adelle M. Stampfer*

RESPONSE

Honorable Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Official Action mailed May 5, 2006, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on April 5, 2002; October 30, 2002; November 11, 2004; and February 24, 2006.

Claims 1-80 are pending in the present application, of which claims 1, 10, 46-49, 66, 67 and 78 are independent. Claims 1-9, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, 34, 36, 38, 40, 42, 44, 46, 48, 50, 52, 54, 56, 58, 60, 62, 64, 66, 68, 70, 72, 74 and 76 have been withdrawn from consideration by the Examiner (page 2, Paper No. 0406). Accordingly, claims 10, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33, 35, 37, 39, 41, 43, 45, 47, 49, 51, 53, 55, 57, 59, 61, 63, 65, 67, 69, 71, 73, 75 and 77-85 are currently elected, of which claims 10, 47, 49, 67 and 78 are independent. For the reasons set

forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 10, 13, 15, 17, 25, 27, 29, 33, 35, 37, 39, 41, 47, 49, 51, 53, 55, 57, 63, 65, 67, 69, 71, 73 and 77-80 under the doctrine of obviousness-type double patenting over claims 20-24, 27-31, 33 and 35 of U.S. Patent No. 6,808,968 to Yamazaki. The Applicant respectfully requests that the double patenting rejections be held in abeyance until an indication of allowable subject matter is made in the present application. At such time, the Applicant will respond to any remaining double patenting rejections.

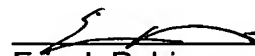
The Official Action rejects claims 10, 11, 13, 15, 17, 19, 21, 25, 27, 29, 31, 33, 35, 37, 39, 41, 43, 45, 47, 49, 53, 55, 57, 59, 61, 63, 65, 67, 71, 73, 75 and 77-85 as obvious based on the combination of U.S. Patent No. 5,789,284 to Yamazaki and U.S. Patent No. 6,821,827 to Nakamura. The Official Action rejects claims 23, 51 and 69 as obvious based on the combination of Yamazaki '284, Nakamura and U.S. Patent No. 6,291,888 to Bhat.

However, Nakamura, as a commonly owned reference under § 102(e), may not be considered for a rejection under § 103. Please note, on October 5, 2005, the Applicant filed a Verified English Translation of the priority document, JP 2001-040837, which was filed February 16, 2001. Nakamura was filed in the U.S. on December 28, 1999, and published on October 25, 2001. As such, Nakamura is only potentially available as prior art under § 102(e). However, subject matter developed by another, which qualifies as prior art only under one or more of subsections 35 U.S.C. §§ 102(e), (f) and (g), is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. § 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made. See MPEP § 2146. Since the disclosure by Nakamura and the claimed invention of the present application were, at the time the invention was made, subject to an obligation of assignment to Semiconductor Energy Laboratory Co., Ltd., Nakamura may not be

considered for a rejection under § 103. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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Eric J. Robinson  
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